

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHUSOU WADAKA, KOICHIRO MISU,
TSUTOMU NAGATSUKA, TOMONORI KIMURA
and SHUMPEI KAMEYAMA

Application No. 09/778,872

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 18, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellants filed Information Disclosure Statements (IDS') on February 8, 2001 and July 2, 2001. It is not clear from the record whether the examiner considered the statements submitted or whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

In addition, in the examiner's Final rejection mailed on October 9, 2002, the examiner rejects the following claims:

- Claims 24-33 and 40 under 35 U.S.C. § 102 as anticipated by Krishnaswamy et al. (Krishnaswamy), Curran, Vale or Japanese Patent No. 5,259,804 (JP '804);
- Claim 34 under 35 U.S.C. § 103 as unpatentable over JP '804, Vale or Krishnaswamy in view of Berlincourt et al. (Berlincourt);
- Claims 35-39, 61 and 62 under 35 U.S.C. § 103 as unpatentable over Krishnaswamy, JP '804, Vale or Currant.

On March 10, 2003, appellants filed an Appeal Brief. On pages 4-6 of the Brief, section VI entitled "Issues," appellants address all the rejections on appeal. On September 11, 2003, the examiner mailed an Examiner's Answer in response to appellants Appeal Brief filed on March 10, 2003. The examiner indicates on page 2, section (6) of the Answer that "appellant's [sic, appellants'] statement of the issues in the brief is correct." However, a review of the Examiner's Answer reveals that the examiner has not argued the rejection of claims 35-39, 61 and 62 under 35 U.S.C. § 103. Therefore, it is not clear from the record whether or not the examiner has dropped the rejection of claims 35-39, 61 and 62, or whether this rejection was inadvertently omitted.

Accordingly, it is

ORDERED that the application is returned to the examiner for resolutions of the following issues:

(1) for consideration of the IDS's filed February 8, 2001 and July 2, 2001;

(2) written notification to appellants of consideration of IDS's;

(3) for clarification of the rejection of claims 35-39, 61 and 62 under 35 U.S.C. § 103, and written notification to appellants as to the status of this rejection; and

(4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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